

REMARKS

Claims 38-41, 44-51, 54-61, and 64-70 remain pending in this application. In the May 23, 2007 Office Action¹, the Examiner rejected claims 38-41, 44-46, 48-51, 54-56, 58-61, 64-66, and 68-70 under 35 U.S.C § 102(b) as being anticipated by U.S. Patent 6,347,333 to Eisendrath et al. ("*Eisendrath*"); and rejected claims 47, 57, and 67 under 35 U.S.C § 103(a) as being unpatentable over *Eisendrath* in view of U.S. Published Patent Application No. 2002/0032790 to Linderman ("*Linderman*"). Applicants traverse each of these rejections and request allowance of the present application, including all pending claims.

I. Rejection under 35 U.S.C § 102(b) by *Eisendrath*

Applicants respectfully traverse the rejection of claims 38-41, 44-46, 48-51, 54-56, 58-61, 64-66, and 68-70 under 35 U.S.C § 102(b) as being anticipated by *Eisendrath*. In order to properly establish anticipation under 35 U.S.C. § 102, "each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913,

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131. Here, *Eisendrath* does not teach or suggest each and every element of the pending claims.

For example, claim 38 recites, *inter alia*, “receiving, by a server, metadata for a course catalog from the external system,” (emphasis added). The Examiner alleges that *Eisendrath* teaches these elements because *Eisendrath* allegedly “disclose[s] a network-based educational system [where a] user may view a course catalog ... and participate in educational courses,” (Office Action, page 3). However, in *Eisendrath*, “[t]he client computers 201-207 can communicate with the host 250 to obtain data stored at the host 250 on servers 241-244,” (*Eisendrath*, col. 4, lines 62-64, emphasis added). Thus, the user of *Eisendrath* is a client and not a “server” as required by claim 38.

Furthermore, the Virtual University Server 231 in Figure 2 of *Eisendrath* also does not constitute the claimed “server” that is “receiving ... metadata for a course catalog from” the servers 241-244 from *Eisendrath*, at least because the servers 241-244 of *Eisendrath* are not an “external system” as claimed. Instead the servers 241-244 are part of the same host 250 as the Virtual University Server 231 as shown in Figure 2 of *Eisendrath*.

Eisendrath also does not teach or suggest, “receiving a response to the track command, wherein the response comprises at least two of a percentage of material from the at least one selected course that has been viewed by the user, a test score associated with material from the at least one selected course, and an amount of time spent viewing material in the at least one electronic course by the user,” as recited by claim 38. The Examiner alleges that *Eisendrath* teaches these elements because

Eisendrath allegedly “disclose[s] that a student's academic progress through course modules, as well as grades may be tracked and displayed, and that a student may view information pertaining to certificates or modules completed (i.e., a score and amount of material viewed),” (Office Action, page 3). Even if, *arguendo*, *Eisendrath* enabled a user to “access a score and amount of material viewed,” as the Examiner alleges, that information is not part of “a response to the track command,” as recited by independent claim 38 (emphasis added). Accordingly, *Eisendrath* fails to teach or suggest each and every element of independent claim 38, and the rejection of this claim under 35 U.S.C § 102(b) is improper and should be withdrawn.

Independent claims 48, 58, 68, 69, and 70, while differing in scope, recite elements similar to those noted above with respect to independent claim 38. Accordingly, the rejection of claims 48, 58, 68, 69, and 70 under 35 U.S.C § 102(b) should be withdrawn at least due the reasons discussed previously.

Claims 39-46, 49-56, and 59-66 depend from claims 38, 48, and 58, respectively, and therefore require all elements thereof. Accordingly the rejection of claims 39-46, 49-56, and 59-66 under 35 U.S.C § 102(b) should be withdrawn at least due to this dependence.

II. Rejection under 35 U.S.C § 103(a) by *Eisendrath* in view of *Linderman*

Applicants traverse the rejection of claims 47, 57, and 67 under 35 U.S.C § 103(a) as being unpatentable over *Eisendrath* in view of *Linderman* and assert that no *prima facie* case of obviousness has been established. To establish a *prima facie* case of obviousness, the prior art, taken separately or in combination, must teach or suggest

all the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006).

Moreover, “in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2. Here, no *prima facie* case of obviousness has been established at least because the prior art fails to teach or suggest each and every element of the claims.

Claims 47, 57, and 67 depend from independent claims 38, 48, and 58 respectively and, therefore, require all elements thereof. As discussed previously, *Eisendrath* fails to teach or suggest each and every element of independent claims 38, 48, and 58. Therefore, *Eisendrath* fails to establish a *prima facie* case of obviousness with respect to dependent claims 47, 57, and 67.

Linderman fails to cure the noted deficiencies of *Eisendrath*. That is, *Linderman* fails to teach or suggest, “receiving, by a server, metadata for a course catalog from the external system,” and “receiving a response to the track command, wherein the response comprises at least two of a percentage of material from the at least one selected course that has been viewed by the user, a test score associated with material from the at least one selected course, and an amount of time spent viewing material in the at least one electronic course by the user,” as recited by claims 38, 48, and 58 and required by claims 47, 57, and 67. Accordingly, *Eisendrath* and *Linderman*, whether taken alone or in combination, fail to establish a *prima facie* case of obviousness with

respect to dependent claims 47, 57, and 67. Accordingly the rejection of these claims under 35 U.S.C § 103(a) should be withdrawn.

CONCLUSION

In view of the foregoing, Applicants, respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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